

Serial No.: 10/016,161
Amdt. Dated June 25, 2004.
Reply to Office Action of April 2, 2004

RD-26440-5

REMARKS

In the Office Action mailed on April 2, 2004 claims 25-36 were rejected under the doctrine of obviousness type double patenting over the claims of co-pending Divisional Application No. 10/020376, now U.S. Patent No. 6583233, and Divisional Application No. 10/020381, now U.S. Patent No. 6608147. In response, the Applicants urge that the requirement for terminal disclaimer is misplaced and that the Examiner should withdraw the requirement for terminal disclaimer for the following reasons.

The Examiner had earlier required an election between 2 groups of claims:

- (1) Claims 1-24, drawn to a method of preparing a copolymer, classified in class 525, subclass various; and
- (2) Claims 25-36, drawn to a method of preparing a hydroxy-terminated oligomer.

Claims 1-24 of the parent Application were drawn to a method for preparing a copolymer. Claim 1 of the parent application recites:

A method for preparing a copolymer of a first polymer which is a polyethersulfone, polyetherketone, or polyetherimide and a second condensation polymer characterized by structural units containing an oxycarbonyl group, which comprises contacting, under reactive conditions, at least one salt of a dihydroxyaromatic compound with at least one substituted aromatic compound of the formula



wherein Z is an activating radical, A^1 is an aromatic radical and X^1 is fluoro, chloro, bromo or nitro, in the presence of said second polymer.

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Claims 25-36 of the parent Application are directed to a method for preparing at least one hydroxy-terminated oligomer of a polyether polymer. Claims 25-36 are currently under examination.

None of the claims of U.S. Patent No. 6583233 or U.S. Patent No. 6608147 recites a method "for preparing at least one hydroxy-terminated oligomer of a polyether polymer". The claims of U.S. Patent No. 6583233 and U.S. Patent No. 6608147 are directed to "a method of preparing a copolymer of a first polymer which is a polyetherimide and a second polymer which is a polycarbonate" (U.S. Patent No. 6608147) and "a method of preparing a copolymer of a first polymer which is a polyethersulfone and a second polymer which is a polycarbonate" (U.S. Patent No. 6583233). All of the claims of U.S. Patent No. 6583233 and U.S. Patent No. 6608147 fall within the scope of "group (1)" claims of the initial restriction; *claims 1-24, drawn to a method of preparing a copolymer, classified in class 525, subclass various.*

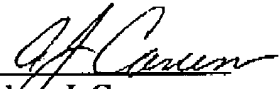
The Applicants note that two principles justifying a requirement for election are: A) the inventions must be independent or distinct as claimed, i.e., they must be patentable (novel and unobvious) over each other (MPEP §802.01 and §803); and B) there must be a serious burden on the Examiner (MPEP §803). The Examiner earlier prevailed in her assertion that the restricted claims represented "independent or distinct inventions" and cannot at this stage properly assert that the claims 25-36 are no longer patentably distinct from the claims of U.S. Patent No. 6583233 and U.S. Patent No. 6608147.

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For these reasons Applicants respectfully request that the rejection of claims 25-36 be withdrawn. A prompt notice of allowance for claims 25-36 is courteously solicited.

Respectfully submitted,


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